REMARKS

Reconsideration and removal of the grounds for rejection are respectfully requested. Claims 1-7 were in the application, claims 1-7 have been cancelled and new claims 8-14 have been substituted therefore.

The examiner objected to the drawings as failing to show areas B1 and B2. Enclosed is a replacement sheet, having a corrected Figure 1 with the areas B1 and B2 indicated.

Claims 1-7 were rejected as being obvious over Moore et al, U.S. Patent no. 6,588,173. The examiner essentially alleged that while Moore failed to disclose use of a bar-code reader, the use of such a device would have been obvious to one of ordinary skill in the art at the time the invention was made. However, in order to uphold a finding of obviousness, there must be some teaching, suggestion or incentive for doing what the applicant has done. ACS Hospital Systs. Inc. v. Montefiori Hospital, 723 F.2d 1572 (Fed. Cir. 1984). Also, "Both the suggestion and the expectation of success must be found in the prior art, not in the applicant's disclosure." In re Dow Chemical Co., 837 F.2d 469 (Fed. Cir. 1988).

The Patent and Trademark Office has the burden under section 103 to establish a prima facia case of obviousness. In re Piasecki 223 USPQ 2d 785 (Fed. Cir. 1984). They can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to an ordinary skill in the art would lead the individual to combine relevant teachings of the references. In re Fine, 837 F.2d 1071 (Fed. Cir. 1988).

Moore only relates to the use of color coding; there is no teaching or suggestion in Moore for the use of any more sophisticated system than that during a machine change-over, and so Moore could lead one away from the applicant's invention. More importantly, there is nothing to

teach or suggest the additional advantages achieved by the present invention.

The claimed method seeks to quickly, efficiently and accurately make a machine change-over, and to control the machine change over by providing a computerized unit for storing the machine parameters and specific components needed to package particular products. When a change over in the product line is indicated, it is the computerized unit which generates the list of items requiring substitution or adjustment. This information is transferred to the hand held unit, which has means to read identification information for confirming which component is to be changed out, which component is to be put in its place, and which dimensions must be adjusted, and to provide this information on a display so that the changeover is accomplished quickly and accurately.

There is a required co-operation between the computerized unit and the hand held unit equipped with the bar code reader. It is not the reader in isolation that is the invention, but the use of the bar code reader with stored and displayed information that enables an improved method of machine change-over to be achieved.

While bar code readers themselves may be known in the art, "it is irrelevant in determining obviousness that all other aspects of the claimed invention are well known in a piecemeal manner, in the art, since virtually every patent can be described as a 'combination patent', or a 'combination of old elements'. The mere fact that the disclosure of teachings of the prior art can be retrospectively combined for purposes of evaluating the obviousness/non-obviousness issue does not make the combination obvious unless the art also suggested the desirability of the combination or the inventor's beneficial results of the advantage to be derived from the combined teaching." Fromson v. Advanced Offset Plate, Inc. 755 F. 2d 1549, 1556

(Fed. Cir. 1985).

At best it might be obvious to try various combinations, but obvious to try is not the standard and absent a teaching or suggestion for doing as the applicants have done, claims 8-14 are believed to be patentable over the cited art.

Based on the above amendment and remarks, favorable consideration and allowance of the application are respectfully requested. However should the examiner believe that direct contact with the applicant's attorney would advance the prosecution of the application, the examiner is invited to telephone the undersigned at the number given below.

Respectfully submitted,

William J. Sapone
William J. Sapone
Registration No. 32,518
Attorney for Applicant(s)

Coleman Sudol Sapone P.C.
714 Colorado Avenue
Bridgeport, CT 06605
Telephone No. (203) 366-3560
Facsimile No. (203) 335-6779